



Paper No. 5

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OFFICE OF PETITIONS

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| In re Application of | : |
| James Lynn Baratuci et al. | : |
| Application No. 10/004,365 | : DECISION REFUSING STATUS |
| Filed: November 10, 2001 | : UNDER 37 CFR 1.47(a) |
| Attorney Docket No. TRUSP0105USA | : |

This is in response to the petition under 37 CFR 1.47(a)¹ filed on March 8, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on November 10, 2001, with a declaration naming James Lynn Baratuci, Patrick Anthony Drda, Steven Michael Milano and Theo J. Van de Pol and signed by all inventors except joint inventor Theo J. Van de Pol. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application" requiring an executed oath or declaration, and a surcharge for the late filing was mailed December 28, 2001.

In support of the petition, joint inventor Baratuci declares that the nonsigning inventor refuses to sign the declaration for the application.

The petition lacks items (1) and (4).

¹ A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

In regards to item (1), the petition does not present a sufficient showing of proof that a copy of the application papers were sent or given to the non-signing inventor for review.² The declaration of joint inventor James J. Baratuci indicates that on November 8, 2000, he sent a copy of the patent application to Mr. van de Pol via FEDEX and that Mr. van de Pol refused to execute the Combined Declaration and Power of Attorney. Mr. Baratuci claims that between the winter of 2000 and the spring of 2001, several telephone conversations ensued between he and Mr. van de Pol and again in August 2001, he sent the application papers to Mr. van de Pol and that it was on those occasions and during that time that Mr. van de Pol continued to refuse to execute the documents, based on advice of counsel.

Petitioners must show proof however that a copy of the application (specification including claims, drawings, if any, and the declaration) was sent or given to the nonsigning inventor for review. Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or further details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Additionally, petitioners must show proof that the non-signing inventors refuse to sign the declaration after being sent or given a copy of the application papers (specification, including claims, drawings, if any, and the declaration).³ Petitioner should indicate the manner in which the refusal was conveyed. Was it in writing or was it a verbal refusal. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide further details of the refusal in an affidavit or declaration of facts.

In regards to item (4), Petitioner has not provided the USPTO with the last known address of Mr. van de Pol.

The petition in this matter indicates that the Combined Declaration and Power of Attorney is executed by the joint inventor on behalf of the omitted inventor who refuses to sign. It should be noted that the Declaration is signed only by joint inventors Baratuci, Drda and Milano on their own behalf. In this regard, petitioners should note that the declaration is acceptable if all the signing inventors signed in their respective signature blocks and the signature block of the non-signing inventor is left blank, or all the signing inventors sign a statement saying that they are signing on behalf of the non-signing inventor. A declaration is not acceptable if there are two or more signing inventors and only one of the signing inventors signed on behalf of the non-signing inventor. The Combined Declaration and Power of Attorney is in compliance with 37 CFR 1.63 and 1.64 as required, however, as indicated above, the petition does not comply with 37 CFR 1.47(a)(1) and (4).

²MPEP 409.03(e).

³Id.

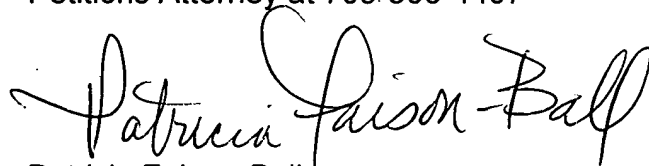
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned
Petitions Attorney at 703-305-4497

A handwritten signature in cursive script, reading "Patricia Faison-Ball". The signature is written in black ink and is positioned above the printed name and title.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy